

Malaysia – Patent Regulations and Fee Changes effective 15 February 2011

The Malaysian Patents (Amendment) Regulations 2011 came into force on 15 February 2011. They bring changes to the official fees and procedures applicable to Malaysian patent applications. The changes are summarized below.

Official Fees

The official fees have been increased across the board by an amount in the range of about 30-60%. Although this is obviously a significant fee increase, it is the first increase for patent official fees in Malaysia since 1995. Our current professional fees remain the same.

Formal Documents for New Patent Applications

The Power of Attorney (Appointment of Patent Agent) that needs simple signature by the applicant, and the Statement Justifying the Applicant's Right to a Patent which is signed by ourselves and briefly explains the applicant's derivation of title from the inventor, are now each subject to the payment of an official fee.

Furthermore, the filing of these documents will be checked at the preliminary examination stage. An adverse formalities report will be issued if the documents are not filed with the initial application. Since there will be additional costs for handling such an adverse report, it is preferable to file these formal documents at the outset wherever possible.

Applicants that file regular patent applications may wish to provide us with a master signed Power of Attorney that we can copy and tailor for each application filed. The Power of Attorney is available for download from our website at <http://www.henrygoh.com/resources/>.

Examination Request

The term for requesting examination of a direct (non-PCT) application has been changed to 18 months from the filing date. The same term applies for requesting deferment of such an application. The Malaysian IP Office (MyIPO) have advised that the previous 2-year term can still be relied on for applications filed prior to 15 February 2011. The period of deferment remains 5 years, and the term for requesting examination of a PCT national phase application is still 4 years from the international filing date.

Expedited Substantive Examination

There are new formal provisions for requesting expedition of substantive examination provided the application has been made available for public inspection. The applicant must first request substantive examination, and then submit a reasoned request for expedition and pay an official fee. If the request is approved, the applicant will be required to pay a substantial fee for the expedited examination. The grounds on which expedited examination can be requested are limited, and include 1) ongoing infringement, 2) the applicant has already commercialized the invention or plans to do so within 2 years, and 3) the invention relates to green technology.

Term for Responding to Examination Report

The term for responding to a substantive examination report has been reduced from 3 months to 2 months. Although not governed by the regulations as such, MyIPO has also indicated it will take a tougher stance on the grant of extensions of time, which remain at the discretion of the Registrar. If expedited examination is requested, the applicant must respond to any adverse report within 3 weeks and no extension will be allowed.

Certificate Fee

The official fee to obtain the patent certificate upon grant has been abolished. We are advised by MyIPO that this fee is still payable for pre-existing applications.

Please do contact your regular Henry Goh professional for further information on any of the above changes. Thank you.

HENRY GOH & CO SDN BHD

Last updated 28 April 2011